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8 **UNITED STATES DISTRICT COURT**
9 **CENTRAL DISTRICT OF CALIFORNIA**
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11 DC COMICS) CV 11-3934 RSWL (OPx)
12)
12 Plaintiff,) **ORDER re: Defendant Mark**
13) **Towle's Motion for**
13 v.) **Partial Summary Judgment**
14) **[41]; Plaintiff DC**
14 MARK TOWLE, an individual) **Comics' Motion for**
15 and d/b/a Gotham Garage,) **Partial Summary Judgment**
15 and DOES 1-10, inclusive,) **[42]**
16)
16 Defendants.)
17

18 On January 30, 2013, Defendant Mark Towle's Motion
19 for Partial Summary Judgment [41] and Plaintiff DC
20 Comics' Motion for Partial Summary Judgment [42] came
21 on for regular calendar before the Court. The Court
22 having reviewed all papers submitted pertaining to
23 these Motions and having considered all arguments
24 presented to the Court, **NOW FINDS AND RULES AS FOLLOWS:**

25 The Court **GRANTS in Part and DENIES in Part**
26 Plaintiff's Motion. The Court **DENIES** Defendant's
27 Motion.

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I. BACKGROUND

This Action stems from a Complaint filed by Plaintiff DC Comics ("Plaintiff") against Defendant Mark Towle d/b/a Gotham Garage ("Defendant") and Does 1 through 10 for (1) Copyright Infringement, (2) Trademark Infringement, and (3) Unfair Competition [1].

A. Undisputed Facts

Plaintiff is a New York General Partnership consisting of E.C. Publications, Inc. and Warner Communications Inc. Pl.'s Statement of Uncontroverted Facts and Conclusions of Law ("SUF") ¶ 1 [43]. Plaintiff is the successor-in-interest to Detective Comics, Inc., National Comics Publications, Inc., National Periodical Publications, Inc. ("National Periodical"), and DC Comics Inc. Id. ¶ 2. Plaintiff is the publisher of comic books featuring the world-famous Batman and his Batmobile. Id. ¶¶ 3-4. Originally introduced in 1941, the Batmobile is a fictional high-tech automobile that Batman employs as his primary mode of transportation. Id. ¶¶ 9-10. Batman and his Batmobile vehicle have appeared in comic books, television shows, and blockbuster movies, including the television series, *Batman*, that first appeared in 1966 and the 1989 film, *Batman*. Id. ¶¶ 7, 13, 27. Plaintiff owns the copyright registrations to the Batman comic books. Id. ¶ 12.

In 1965, Plaintiff's predecessor, National Periodical, licensed its Batman literary property to

1 American Broadcasting Company ("ABC") for use in the
2 1966 *Batman* television series, which starred Adam West
3 as Batman. Id. ¶ 13. ABC contracted with Greenway
4 Productions, Inc. ("Greenway") and Twentieth Century-
5 Fox Television, Inc. ("Fox") to produce the television
6 series. Id. ¶ 15. Fox and Greenway own the copyright
7 registrations for all of the episodes of the 1960s
8 *Batman* television series. Id. ¶ 16. The Batmobile
9 that appeared in the television series (hereinafter,
10 "the 1966 Batmobile") was manufactured by Barris Kustom
11 City and designed by George Barris. Id. ¶ 19. Barris
12 Kustom City retained title to the original Batmobile
13 vehicle that was used in the filming of the television
14 show. Id.



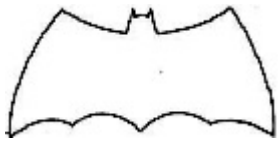
15 Plaintiff also licensed its Batman literary
16 property to produce motion films. In 1979, Plaintiff
17 entered into an agreement with Batman Productions,
18 Inc., granting the use of its Batman literary property
19 in feature-length motion pictures. Id. ¶ 25. These
20 rights were assigned to Warner Bros. Inc. ("Warner
21 Bros.") and resulted in a series of Batman films,
22 including the 1989 *Batman* film to which Warner Bros.
23 owns the copyright registration. Id. ¶¶ 27-28. Anton
24 Furst was hired to construct the Batmobile that
25 appeared in the 1989 film (hereinafter, "the 1989
26 Batmobile"). Id. ¶ 31.

27 Plaintiff also owns a number of Batman-related
28 trademarks, including, the BATMOBILE wordmark, the BAT

1 emblem design mark, the BAT REP II design mark, the
2 BATMAN wordmark, and other variations of the Batman
3 symbol. Id. ¶ 35; see below. The trademarks are
4 registered in various classes, and appear on
5 merchandise such as toy figurines and automobiles,
6 apparel, and household goods. Id. ¶¶ 37, 40.
7 Plaintiff also licenses to Fiberglass Freaks the
8 manufacture and customization of full-size automobiles
9 into the Batmobile vehicles featuring Plaintiff's
10 trademarks. Id. ¶ 39. Plaintiff has also contracted
11 with George Barris, the designer of the original 1966
12 Batmobile, to produce replicas of the 1966 Batmobile,
13 featuring Plaintiff's trademarks, and to exhibit them
14 around the world. Id. ¶ 38.

15 Defendant is the owner, operator, and manager of a
16 business producing custom cars modeled after vehicles
17 found in various television shows and movies. Id. ¶
18 44. Defendant has been producing and selling replica
19 vehicles based on the 1966 and 1989 Batmobile vehicles
20 and car kits that allow others to customize their
21 vehicles into the Batmobile. Id. ¶¶ 45-48, 50.
22 Defendant has also manufactured and distributed various
23 automobile parts and accessories featuring the Batman
24 trademarks. Id. ¶ 51. Defendant does business through
25 the websites www.gothamgarage.net,
26 www.gothamgarage.com, www.marktowle.com, and
27 www.batmobilereplicas.com, which use Plaintiff's
28 trademarks to promote Defendant's business. Id. ¶¶ 52-

53.

Plaintiff's Trademarks		
<u>Reg. No.</u>	<u>Class</u>	<u>Mark</u>
1581725	28	 Bat Emblem
1581593	21	
1581659	25	
2119266	16	
3299017	9	 Bat Emblem (Batman Begins)
3110604	16	
3326043	25	
3313612	28	
1219120	16	 Bat Rep II
856045	25	BATMAN (Word Mark)
858860	28	
828412	21	
2457655	41	
1652640	41	
839561	16	
1221720	16	
1587507	9	

1	4246497	40	BATMOBILE (Word Mark)
2	1124961	28	
3	1179342	28	
4	Serial No.	12	
5	85143617		

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1 **B. Procedural History**

2 On May 6, 2011, Plaintiff filed its Complaint
3 against Defendant [1], and on November 22, 2011,
4 Plaintiff filed a First Amended Complaint [13]. In its
5 First Amended Complaint ("FAC"), Plaintiff asserts that
6 the Defendant has infringed on the copyrighted versions
7 of the 1966 Batmobile and the 1989 Batmobile.
8 Plaintiff also asserts that Defendant has infringed
9 upon its trademarks in marketing and selling these
10 infringing vehicles.

11 On December 16, 2011, Defendant filed a Motion to
12 Dismiss Claim of Copyright Infringement pursuant to
13 Federal Rule of Civil Procedure 12(b)(6) [15]. The
14 Court denied the motion on January 26, 2012 [21]. On
15 February 14, 2012, Defendant filed an Answer, asserting
16 several affirmative defenses, including laches, unclean
17 hands, and fair use [23].

18 On December 26, 2012, Defendant filed the present
19 Motion for Partial Summary Judgment [41] and Plaintiff
20 filed the present Motion for Partial Summary Judgment
21 [42].

22 The Parties' present motions seek summary judgment
23 as to Plaintiff's trademark, copyright, and unfair
24 competition causes of action, and on Defendant's laches
25 defense.

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II. LEGAL STANDARD

Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56. A genuine issue is one in which the evidence is such that a reasonable fact-finder could return a verdict for the non-moving party. Anderson v. Liberty Lobby, 477 U.S. 242, 248 (1986).

A party seeking summary judgment always bears the initial burden of establishing the absence of a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). "Where the moving party will have the burden of proof on an issue at trial, the movant must affirmatively demonstrate that no reasonable trier of fact could find other than for the moving party." Soremekun v. Thrifty Payless, Inc., 509 F.3d 978, 984 (2007).

Once the moving party makes this showing, the non-moving party must set forth facts showing that a genuine issue of disputed fact remains. Celotex, 477 U.S. at 322. The non-moving party is required by Federal Rule of Civil Procedure Rule 56 to go beyond the pleadings and designate specific facts showing a genuine issue for trial exists. Id. at 324.

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III. DISCUSSION

A. Evidentiary Objections

In ruling on a Motion for Summary Judgment, courts consider only evidence that would be admissible at trial. Fed. R. Civ. P. 56. Here, the Parties have filed over forty evidentiary objections. Given the number of objections made by the Parties, the Court will address the evidentiary objections in two separate orders. For the purposes of this ruling, the Court has considered only admissible evidence.

B. Trademark Infringement

To sustain a claim for trademark infringement, Plaintiff must show (1) that it has valid trademark rights; and (2) that Defendant's use of a similar mark is likely to cause confusion. Applied Info. Sci. Corp. v. eBAY, Inc., 511 F.3d 966, 969 (9th Cir. 2007). "The core element of trademark infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely to confuse customers about the source of the products." E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1290 (9th Cir. 1992). Courts look to the following factors, known as the Sleekcraft test, for guidance in determining the likelihood of confusion: (1) strength of Plaintiff's mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7)

1 defendant's intent in selecting the mark; and the (8)
2 likelihood of expansion of the product lines. Dr.
3 Seuss Enters. v. Penguin Books USA, Inc., 109 F.3d
4 1394, 1404 (9th Cir. 1997) (citing AMF Inc. v.
5 Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir.
6 1979)).

7 Although courts should consider these factors to
8 determine the issue of likelihood of confusion, "[n]o
9 mechanistic formula or list can set forth in advance
10 the variety of elements that comprise the market
11 context from which likelihood of confusion must be
12 determined." Id. (citing Restatement (Third) of
13 Unfair Competition § 21, comment a (1995)) (internal
14 quotations omitted). As such, this "list is not
15 exhaustive" and "[o]ther variables may come into play
16 depending on the particular facts presented." Id.
17 (citing Sleekcraft, 599 F.2d at 348 n.11).

18 Furthermore, although disfavored in trademark
19 infringement cases, summary judgment may be entered
20 when no genuine issue of material fact exists. See
21 Surfvivor Media, Inc. v. Survivor Prods., 406 F.3d 625,
22 630 (9th Cir. 2005). Whether likelihood of confusion
23 is more a question of law or one of fact can depend on
24 the circumstances of each particular case. Alpha
25 Indus., Inc. v. Alpha Steel Tube & Shapes, Inc., 616
26 F.2d 440, 443 (9th Cir. 1980). And, a question of fact
27 may be resolved as a matter of law if reasonable minds
28 cannot differ and the evidence permits only one

1 conclusion. See Sanders v. Parker Drilling Co., 911
2 F.2d 191, 194 (9th Cir. 1990).

3 The legal conclusion that confusion is likely must
4 rest on the particular facts of the case, but when all
5 of the material facts have been determined, the
6 ultimate determination of likelihood of confusion lies
7 within the exclusive jurisdiction of the court. See
8 Alpha Indus, Inc., 616 F.2d at 443-44; see also
9 Sleekcraft, 599 F.2d at 348.

10 First, the Court finds that Plaintiff has valid
11 trademark rights in the trademarks at issue in this
12 case. Under the Lanham Act, registration of a
13 trademark creates a rebuttable presumption that the
14 mark is valid, but the presumption evaporates as soon
15 as evidence of invalidity is presented. 15 U.S.C. §
16 1051. Plaintiff owns the Bat Emblem mark, the Bat
17 Emblem (Batman Begins) mark, Bat Rep II mark, the
18 BATMAN word mark, and the BATMOBILE word mark in
19 various classes. Defendant puts forth no evidence or
20 argument to demonstrate that these marks are invalid.

21 Defendant's only argument with respect to
22 Plaintiff's trademark infringement claim is that
23 Plaintiff did not own the BATMOBILE mark in Class 12
24 for "automobiles" at the time Plaintiff filed this
25 Action and that registration in Class 40 did not occur
26 until November 20, 2012. However, under the Lanham
27 Act, to establish standing to sue for trademark
28 infringement, a plaintiff must show that he or she is

1 either (1) the owner of a federal mark registration,
2 (2) the owner of an unregistered mark, or (3) a
3 nonowner with a cognizable interest in the allegedly
4 infringed trademark. Halicki Films, LLC v. Sanderson
5 Sales & Mktg., 547 F.3d 1213, 1225-26 (9th Cir. 2008).
6 Plaintiff only needs to demonstrate that it is the
7 registered owner of a mark for any class of products,
8 even one that does not compete directly with
9 Defendant's products. Id. at 1227. "The question of
10 whether the products on which the allegedly infringing
11 mark appears are sufficiently related to goods sold by
12 the plaintiff such that the defendant's actions qualify
13 as infringement is, by contrast, a merits question."
14 Id.

15 Defendant does not dispute that he has used or uses
16 Plaintiff's trademarks. In fact, Defendant does really
17 contest Plaintiff's trademark claim. Defendant does
18 not dispute that he has manufactured and distributed
19 automobile parts and accessories featuring the
20 trademarks at issue. Def.'s Stmt. of Genuine Issues
21 ("GIF") ¶ 51 [66]. For example, Defendant produced
22 vehicle floor mats with bat symbols on them. Drey
23 Decl. Ex. H [55]. The vehicle doors of Defendant's
24 1966 Batmobile replicas also have bat symbols on them.
25 Joint Stipulation, Ex. 24 [45].¹ The fire extinguisher
26

27 ¹ The Parties filed a "Joint Stipulation" stating that the
28 Parties stipulate to certain facts and evidence, including as to
the authenticity of certain exhibits [45]. For the purposes of
the present motions, the Court grants the stipulation.

1 in the 1966 Batmobile replica also has a bat symbol on
2 it. Id. Defendant does not dispute that he does
3 business through a website called
4 batmobilereplicas.com.² GIF ¶ 52. He also does not
5 dispute that he uses these trademarks to promote his
6 business. Id. ¶ 53.

7 Next, the Court finds that Defendant's unauthorized
8 use of Plaintiff's trademarks causes a likelihood of
9 confusion—that is, whether the similarity of the marks
10 is likely to confuse customers about the source of the
11 products. Brookfield Commc'ns, Inc. v. W. Coast Entm't
12 Corp., 174 F.3d 1036, 1053 (9th Cir. 1999).






13 First, with respect to similarity of the marks,
14 "the greater the similarity between the two marks at
15 issue, the greater the likelihood of confusion." Id.
16 at 1206. In the similarity analysis: "(1) Marks should
17 be considered in their entirety and as they appear in
18 the marketplace; (2) Similarity is best adjudged by
19 appearance, sound, and meaning; and (3) Similarities
20 weigh more heavily than differences." Entrepreneur
21 Media, Inc. v. Smith, 279 F.3d 1135, 1144 (9th Cir.
22 2002). "[S]imilarity of design is determined by
23 considering the overall impression created by the mark
24 as a whole rather than simply comparing individual
25 features." adidas-Am., Inc. v. Payless Shoesource,
26 Inc., 546 F. Supp. 2d 1029, 1052 (D. Or. 2008) (citing

28 ² Use of a trademark in a domain name constitutes "use"
under the Lanham Act. Brookfield, 174 F.3d at 1053.

1 Exxon Corp. v. Texas Motor Exch., Inc., 628 F.2d 500,
2 505 (5th Cir. 1980)). There is no dispute that
3 Defendant has used marks that are identical to
4 Plaintiff's registered marks. For example, Defendant
5 has used the BATMAN and BATMOBILE word marks on his
6 advertising and promotional materials. See, e.g., GIF
7 ¶ 52. Further, Defendant also has used various bat
8 symbols that are very similar to the BAT Emblem, BAT
9 Emblem (Batman Begins) and BAT REP II marks. See Joint
10 Stipulation, Ex. 24. For example, the bat symbol
11 appearing on the vehicle doors for the 1966 Batmobile
12 replicas is a stylized bat. Defendant's bat symbols
13 are slightly different from Plaintiff's registered
14 trademarks, but Defendant's marks appear substantially
15 the same overall.

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Defendant's Marks	Plaintiff's Marks
	Bat Emblem 
	Bat Emblem (Batman Begins) 
	Bat Rep II 

Thus, there is no genuine issue of fact regarding the similarity of the marks.

Second, the strength of the trademarks at issue here weigh in favor of finding a likelihood of confusion. The purpose of examining the strength of the plaintiff's mark is to determine the scope of trademark protection to which the mark is entitled. See Entrepreneur Media, 279 F.3d at 1141. The more

1 unique the mark, the greater the degree of protection.
2 See id. Trademarks may be sorted into five categories
3 of increased strength and distinctiveness: (1) generic;
4 (2) descriptive; (3) suggestive; (4) arbitrary; or (5)
5 fanciful. Two Pesos, Inc., v. Taco Cabana, Inc., 505
6 U.S. 763, 768 (1992). Fanciful marks, the strongest
7 type, are "wholly made-up terms," such as "Clorox"
8 bleach. Brookfield, 174 F.3d at 1058 n.19. "Fanciful"
9 marks consist of "coined phrases" that also have no
10 commonly known connection with the product at hand.
11 See Dreamwerks Prod. Grp., Inc. v. SKG Studio, 142 F.3d
12 1127, 1130 n.7 (9th Cir. 1998) (holding that "Kodak" is
13 a fanciful mark). A mark is "strong" if it is
14 memorable and if the public would likely associate it
15 with the mark's owner. Brookfield, 174 F.3d at 1058.
16 As the Ninth Circuit recently explained, "[t]he
17 stronger a mark – meaning the more likely it is to be
18 remembered and associated in the public mind with the
19 mark's owner – the greater the protection it is
20 accorded by the trademark laws." Id. at 1058.

21 The marks at issue here include a series of design
22 marks featuring a bat as well as the word marks
23 BATMOBILE and BATMAN. The bat design marks are
24 distinct. The terms BATMOBILE and BATMAN are fanciful
25 words, as they are coined phrases that evoke the "bat"
26 persona of the Batman comic book character. The public
27 would likely associate the marks with Plaintiff's
28 Batman comic books, merchandise, motion pictures, and

1 television programs.

2 Third, with regard to the issue of actual
3 confusion, the Ninth Circuit has recognized that
4 evidence of actual confusion is not required to
5 establish likelihood of confusion. See Am. Intern.
6 Grp., Inc. v. Am. Intern. Bank, 926 F.2d 829 (9th Cir.
7 1991). Nevertheless, Defendant admits here that "most"
8 of his potential customers asked if he had a
9 relationship with Warner Bros. or was licensed by
10 Warner Bros. Drey Decl. Ex. H, at 94:21-95:14 (Towle
11 Dep.). As revealed at the hearing on the present
12 motions, Warner Bros. is an affiliated entity. This
13 evidence strongly suggests that there was actual
14 confusion, as customers wondered whether Defendant was
15 authorized to use Plaintiff's marks. "Initial interest
16 confusion is customer confusion that creates initial
17 interest in a competitor's product. Although dispelled
18 before an actual sale occurs, initial interest
19 confusion impermissibly capitalizes on the goodwill
20 associated with a mark and is therefore actionable
21 trademark infringement." Playboy Enters., Inc. v.
22 Netscape Commc'ns Corp., 354 F.3d 1020, 1025 (9th Cir.
23 2004).

24 Fourth, the proximity or relatedness of the goods
25 favors a finding of likelihood of confusion. Goods are
26 proximate if they are "similar in use and function" and
27 "would be reasonably thought by the buying public to
28 come from the same source if sold under the same mark."

1 Sleekcraft, 599 F.2d at 348, 350. "Where goods are
2 related or complementary, the danger of consumer
3 confusion is heightened." E. & J. Gallo Winery, 967
4 F.2d at 1291. The goods here are the same. Defendant
5 manufactures replicas of the 1989 and 1966 Batmobile
6 vehicles, and emblazon car parts and accessories with
7 the bat symbol. Plaintiff offers full-size and toy
8 versions of the Batmobile, using its registered
9 trademarks. Plaintiff also offers car accessories
10 featuring their trademarks, including car mats and
11 wheel covers. Kogan Decl. Ex. A. This factor weighs
12 in favor of Plaintiff.

13 Fifth, the Court must next consider "whether the
14 predominant purchasers of the parties' goods are
15 similar or different, and whether the parties'
16 marketing approaches resemble one another." Aurora
17 World, Inc. v. Ty, Inc., 719 F.Supp. 2d 1115, 1162
18 (citing Grey v. Meijer, Inc., 295 F.3d 641 (6th Cir.
19 2002)). The greater the degree of overlap, the more
20 likely there is to be confusion. Sleekcraft, 599 F.2d
21 at 353. Here, Plaintiff and Defendant are in direct
22 competition. The undisputed facts show that they
23 directly market their products online and at car shows.
24 Kogan Decl., Exs. A, H. As such, this factor favors a
25 finding of likelihood of confusion.

26 Sixth, the Court needs to consider the type of
27 goods and the degree of care likely to be exercised by
28 the purchasers. Likelihood of confusion is determined

1 on the basis of a "reasonably prudent consumer," so
2 courts have expected consumers "to be more discerning –
3 and less easily confused – when [they are] purchasing
4 expensive items." Brookfield, 174 F.3d at 1060. "On
5 the other hand, when dealing with inexpensive products,
6 customers are likely to exercise less care, thus making
7 confusion more likely." Id. Defendant's replica
8 vehicles are expensive goods and the reasonably prudent
9 consumer would likely be more discriminating and likely
10 to ask questions regarding his product. Thus, this
11 factor weighs against finding a likelihood of
12 confusion.

13 Seventh, the defendant's intent in selecting the
14 mark must also be evaluated in determining the
15 likelihood of confusion. Knowing adoption of a mark
16 that is closely similar to one that is used by another
17 is a basis for inferring intent to deceive the public,
18 which is "strong evidence of a likelihood of
19 confusion." See Official Airline Guides, Inc. v. Goss,
20 6 F.3d 1385, 1394 (9th Cir. 1993). Here, Defendant
21 admits his knowledge of the Batman property including
22 the Batmobile vehicles and the trademarks, and he
23 knowingly copied the marks. SUF ¶ 54. This permits an
24 inference of an intent to deceive the public.

25 Lastly, the Court can look to the likelihood of
26 expansion of the product lines. A strong possibility
27 that either party will expand its business to compete
28 with the other weighs in favor of finding infringement.

1 Sleekcraft, 599 F.2d at 354. However, where, as here,
2 the Parties already compete to a significant degree
3 because they sell related products and use similar
4 marketing channels, this factor is relatively
5 unimportant to the likelihood of confusion analysis.
6 See Brookfield, 174 F.3d at 1055. Neither Party has
7 submitted evidence of planned expansion, and Plaintiff
8 does not allege that Defendant's presence is hindering
9 its expansion plans.

10 Based on the foregoing, no triable issues of fact
11 exist as to whether Defendant's use of Plaintiff's
12 marks is likely to confuse United States consumers.
13 Furthermore, Defendant has not met his burden to set
14 forth facts showing that genuine issues of disputed
15 fact remain with regard to a finding of likelihood of
16 confusion. See PepsiCo, Inc., 27 U.S.P.Q. 2d 1948,
17 1950 (C.D. Cal. 1993). In fact, the relevant
18 Sleekcraft factors support a finding of likelihood of
19 confusion as a matter of law. In light of this finding
20 and the fact that there are no triable issues of fact
21 with regard to the validity of Plaintiff's marks, the
22 Court **GRANTS** Plaintiff's Motion for Partial Summary
23 Judgment as to Plaintiff's trademark infringement claim
24 and **DENIES** Defendant's Motion as to this claim.

25 **C. Unfair Competition**

26 Whether Defendant's sale of replica Batmobile
27 vehicles is likely to confuse United States consumers
28 is also critical in determining whether the Court

1 should grant summary judgment on Plaintiff's claim for
2 common law unfair competition. The element of
3 likelihood of confusion also applies to this claim.

4 Moreover, the courts have uniformly held that
5 common law and statutory trademark infringement are
6 merely specific aspects of unfair competition. New
7 West Corp. v. NYM Co. of Cal., Inc., 595 F.2d 1194,
8 1201 (9th Cir. 1979). Under the Lanham Act, the
9 ultimate test is whether the public is likely to be
10 deceived or confused by the similarity of the marks.
11 Smith v. Chanel, Inc., 402 F.2d 562, 563 (9th Cir.
12 1968). "Whether we call the violation infringement,
13 unfair competition or false designation of origin, the
14 test is identical - is there a 'likelihood of
15 confusion?'" New West Corp., 595 F.2d at 1201.

16 The decisive test of common law unfair competition
17 is whether the public is likely to be deceived about
18 the source of goods or services by the defendant's
19 conduct. Academy of Motion Picture Arts and Sci. v.
20 Benson, 15 Cal. 2d 685, 690 (1940); South Bay Chevrolet
21 v. Gen. Motors Acceptance Corp., 72 Cal. App. 4th 861,
22 865 (1999). The likelihood of public confusion,
23 although innocently created, will warrant injunctive
24 relief against unfair competition. Tomlin v. Walt
25 Disney Prods., 18 Cal. App. 3d 226, 231 (1971).

26 Defendant has not demonstrated that there is a
27 triable issue of fact as to whether Defendant's use of
28 bat symbols and Plaintiff's trademarks is likely to

1 confuse customers. As courts have uniformly held that
2 common law and statutory trademark infringement are
3 merely specific aspects of unfair competition, a
4 finding of likelihood of confusion under Plaintiff's
5 trademark infringement claim also supports a finding of
6 likelihood of confusion under Plaintiff's common law
7 unfair competition claim. For the foregoing reasons,
8 the Court **GRANTS** Plaintiff's Motion for Partial Summary
9 Judgment as to its unfair competition claim and **DENIES**
10 Defendant's Motion as to this claim.

11 **D. Copyright Infringement**

12 To establish copyright infringement, two elements
13 must be proven: 1) ownership of a valid copyright; and
14 2) copying of protected elements of the plaintiff's
15 work. See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.,
16 499 U.S. 340, 361 (1991).

17 Copying may be established by showing that the
18 works in question are "substantially similar in their
19 protected elements" and that the infringing party had
20 access to the copyrighted work. Metcalf v. Bochco, 294
21 F.3d 1069, 1072 (9th Cir. 2002).

22 A plaintiff satisfies the access element by showing
23 that a defendant had "an opportunity to view or to copy
24 plaintiff's work." Three Boys Music Corp. v. Bolton,
25 212 F.3d 477, 482 (2000) (citing Sid and Marty Krofft
26 Television Prods., Inc. v. McDonald's Corp., 562 F.2d
27 1157, 1172 (9th Cir. 1977)). Where a high degree of
28 access is shown, a lower standard of proof of

1 substantial similarity is required. Switsky v. Carey,
2 376 F.3d 841, 844 (9th Cir. 2004). This is known as
3 the "inverse ratio rule". Shaw v. Lindheim, 919 F.2d
4 1353, 1356 (9th Cir. 1990).

5 In analyzing whether the two works are
6 substantially similar, the court must first distinguish
7 between the protectable and unprotectable material
8 because a party claiming infringement may place no
9 reliance upon any similarity in expression resulting
10 from unprotected elements. Apple v. Microsoft, 35 F.3d
11 1435, 1446 (9th Cir. 1994) (quotation omitted). Then,
12 a two-part test is used to determine whether the two
13 works are substantially similar: an "intrinsic" and
14 "extrinsic" part. As it evolved, the test was
15 clarified by the Court in Apple Computer v. Microsoft
16 Corp.:

17 [T]he extrinsic test now objectively considers
18 whether there are substantial similarities in both
19 ideas and expression, whereas the intrinsic test
20 continues to measure expression subjectively.
21 35 F.3d 1435, 1442 (9th Cir. 1994). "The intrinsic
22 test . . . should measure substantial similarity in
23 expressions . . . depending on the response of the
24 ordinary reasonable person. . . . [I]t does not depend
25 on the type of external criteria and analysis which
26 marks the extrinsic test." Shaw, 919 F.2d at 1356
27 (internal quotations omitted). In decisions under the
28 intrinsic test, "analytic dissection and expert

1 testimony are not appropriate." Id. "Once the
2 extrinsic test is satisfied, the fact finder applies
3 the intrinsic test." Three Boys Music Corp., 212 F.3d
4 at 485.

5 Defendant disputes that Plaintiff has established
6 that it owns valid copyrights to the 1966 and 1989
7 Batmobile vehicles and that the Batmobiles are
8 copyrightable under the Copyright Act. Otherwise,
9 Defendant does not deny that he has produced replicas
10 of the 1966 and 1989 Batmobile.

11 As a preliminary matter, the Court addresses
12 Defendant's argument that Plaintiff should not be able
13 to allege infringement of the 1966 and 1989 Batmobile
14 vehicles because the copyright registrations for the
15 1966 *Batman* television show and 1989 *Batman* film were
16 not identified in the First Amended Complaint.
17 Defendant also claims that Plaintiff should be
18 sanctioned under Federal Rule of Civil Procedure 11 for
19 this alleged litigation misconduct. The Court finds
20 that these arguments wholly lack merit. The body of
21 the First Amended Complaint identifies the 1966 and
22 1989 Batmobile vehicles, the television series, and the
23 1989 movie. FAC ¶¶ 8, 9, 11. The FAC states that the
24 Batmobile is copyrightable subject matter. Moreover,
25 Plaintiff does not claim in the FAC that Plaintiff owns
26 the copyright registration to the 1989 film or the 1966
27 television series. Plaintiff does not state that
28 Exhibit A represented the only copyrights in issue in

1 this Action. Exhibit A is there to show that Plaintiff
2 is the owner of all the Batman literary property
3 because of its ownership of the copyrights listed in
4 Exhibit A.

5 Furthermore, any surprise that Defendant is
6 claiming based on Plaintiff's alleged failure to
7 identify the copyright registrations for the 1989 film
8 and the 1966 television series is disingenuous. As
9 Plaintiff points out, Defendant himself requested
10 judicial notice of these registrations in his Motion to
11 Dismiss [15], and thus knew that Plaintiff's copyright
12 action involves these registrations.

13 **1. Plaintiff Reserved Rights to the 1966 and 1989**
14 **Batmobiles**

15 "Under copyright law, only copyright owners and
16 exclusive licensees of copyright may enforce a
17 copyright or a license." Sybersound Records, Inc. v.
18 UAV Corp., 517 F.3d 1137, 1144 (9th Cir. 2008) (citing
19 17 U.S.C. § 501(b)) (conferring standing only to the
20 "legal or beneficial owner of an exclusive right who is
21 entitled . . . to institute an action for any
22 infringement . . . while he or she is the owner of
23 it.") (internal quotation marks omitted).

24 Defendant's main argument is that Plaintiff does
25 not own the copyright registrations to the 1966 *Batman*
26 television show and the 1989 *Batman* film. Therefore,
27 according to Defendant, Plaintiff does own any interest
28 in the 1966 and 1989 Batmobile vehicles. It is true

1 that Greenway and Fox are the owners of the copyright
2 registrations to the episodes of the 1966 *Batman*
3 television series. SUF ¶ 16. Warner Bros. owns the
4 copyright registration to the 1989 film. Id. ¶ 28.
5 However, the relevant licensing agreements between
6 Plaintiff and its licensees indicate that Plaintiff
7 reserved all rights to the characters and elements
8 depicted in the *Batman* television series and the 1989
9 *Batman* film, and obtained exclusive merchandising
10 rights to the 1966 and 1989 works.³ These exclusive
11 rights are sufficient to afford Plaintiff standing.

12 In 1965, Plaintiff's predecessor, National
13 Periodical, entered into a licensing agreement with ABC
14 granting ABC rights to use the Batman literary property
15 to develop the *Batman* television show, including rights
16 to "adapt, arrange, change, transpose, add to and
17 subtract from said property" and "to secure copyright
18 and renewals and extensions of copyright". Joint
19 Stipulation, Ex. 13, at 2-3. In the agreement,
20 Plaintiff reserves all "merchandising" rights, defined
21 as the

22 sole and exclusive right to produce and sell,
23 license or grant to others the right to produce and
24

25 ³ Plaintiff failed to provide any substantive briefing on
26 its copyright interest in the Batmobile. Instead it resorted to
27 conclusory assertions that it owns rights to the 1966 and 1988
28 Batmobile vehicles. Although the relevant agreements make clear
that Plaintiff retained exclusive rights to the Batmobile
literary property, Plaintiff was still required to brief the
Court on this issue.

1 sell or license or to enter into agreements with
2 respect to the production, distribution and
3 exploitation of endorsements, commercial tie-ups or
4 manufacturing privileges under which a commodity,
5 product or service is made, manufactured, or
6 distributed under the name of "Batman" or any other
7 character in the comic book series entitled
8 "Batman", or under a name which incorporates any
9 phrase, clause or expression used . . . in the
10 television series. . . .

11 Id. at 12-13, ¶ 6(A). Paragraph 6(C) of the licensing
12 agreement provides that National Periodical would pay
13 ABC a share of the income derived from the exploitation
14 of this exclusive merchandising right. Thus, the
15 license agreement clearly entitles Plaintiff an
16 exclusive right to sell, distribute, and manufacture
17 products derived from the elements that appeared in the
18 *Batman* television show, including the Batmobile. The
19 Court's objective in the construction of the language
20 used in the contract is to determine and effectuate the
21 intention of the parties. Winet v. Price, 4 Cal. App.
22 4th 1159, 1166 (1992). If contractual language is
23 clear and explicit, it governs. Bank of the West v.
24 Superior Court, 2 Cal. 4th 1254, 1264 (1992).

25 This interpretation of the license agreement is
26 consistent with a 1966 agreement involving National
27 Periodical, Fox, Greenway, and George Barris, the
28 designer of the 1966 Batmobile. In the agreement,

1 Plaintiff specifically reserved rights in the design of
2 the Batmobile:

3 WHEREAS, NATIONAL PERIODICAL PUBLICATIONS, INC. is
4 the owner of all copyrights, trademarks and all
5 other rights including commercial and exploitive
6 rights to the feature, BATMAN, and to all the
7 contents of the said feature, including the
8 Batmobile

9 . . .

10 Notwithstanding anything to the contrary herein
11 contained, NATIONAL PERIODICAL (Plaintiff's
12 predecessor in interest) acknowledges that BARRIS
13 is the owner of the vehicle known as Batmobile I as
14 used in the BATMAN television series and feature
15 motion picture and that BARRIS, FOX and GREENWAY
16 are the joint owners of the design of said
17 Batmobile I as provided for in Article 7 of that
18 certain agreement between FOX and Greenway, and
19 BARRIS, dated September 1, 1965, as follows:

20 7. Any and all right, title and interest in and to
21 the design of Batmobile I resulting from the
22 application of the required Batmobile features in
23 and to Owner's prototype Lincoln chassis, save and
24 except the name "Batmobile" and the Batmobile
25 features set forth in Article 10 hereof and in the
26 drawings and exhibits attached hereto, and of the
27 completed Batmobile provided for in Article 2
28 hereof, shall forever be vested in and Owned

1 jointly by Owner and Producer, **subject only to any**
2 **and all right, title and interest of National**
3 **Periodical Publications, Inc. . . . in and to said**
4 **Batmobile features in said design.**

5 Joint Stipulation, Ex. 15 (emphasis added). The
6 unambiguous terms of the contract indicate that
7 Plaintiff reserved rights to the 1966 Batmobile.

8 Plaintiff also reserved rights to the Batmobile
9 depicted in the 1989 motion picture. In 1979,
10 Plaintiff entered into a licensing agreement with
11 Batman Productions, Inc., who later transferred its
12 rights to Warner Bros., granting Batman Productions
13 option rights to create a motion picture using the
14 Batman literary property. Joint Stipulation, Ex. 16,
15 Art. I, ¶ 1. The contract states that Plaintiff
16 reserved all "merchandising rights" with respect to the
17 new characters, additional characters, new elements,
18 and additional elements, of any motion picture produced
19 via the agreement. Id. at Article II, ¶ 5(c). Under
20 the agreement "additional characters" is defined as
21 any fictional character or characters newly created
22 by [Batman Productions] and which, but for the
23 operation of this agreement, would constitute an
24 infringement of DC's copyright or trademark in or
25 to any of the characters constituting the Property.
26 . . or any characters contained in the Property who
27 are newly costumed or in any way altered by [Batman
28 Productions] for any motion pictures.

1 Id. at Art. II, ¶ 11. "Additional elements" is defined
2 as "any device or thing newly created by [Batman
3 Productions] and which, but for the operation of this
4 agreement, would constitute an infringement of DC's
5 copyright or trademark in or to any device or thing
6 contained in the Property." Id. The licensing
7 agreement explicitly defined the Batmobile as being
8 part of the "Property" licensed to Batman Productions.
9 Id. at Art. I, ¶ 4(b). Not only did Plaintiff reserve
10 these exclusive merchandising rights, Plaintiff also
11 reserved rights to copyright and trademark any
12 additional characters or elements featured in future
13 Batman motion pictures. Id. at Art. II, ¶¶ 5(c), 11.

14 Based on these agreements reserving exclusive
15 ownership rights to the 1989 and 1966 Batmobiles,
16 Plaintiff has standing to assert this copyright
17 infringement action. See Halicki Films LLC, v.
18 Sanderson Sales and Mktg. et al., 547 F.3d 1213, 1220
19 (9th Cir. 2008) (Plaintiff's reservation of
20 merchandising rights provides standing in copyright
21 infringement action).

22 **2. Defendant's Replica Batmobiles Are Unauthorized**
23 **Derivative Works**

24 Even if Plaintiff did not expressly reserve rights
25 to the Batman and Batmobile elements appearing in the
26 *Batman* movie and television show, Plaintiff is also
27 entitled to sue for infringement because it clearly
28 owns copyrights to the original comic book series in

1 which the Batmobile originally appeared. As the
2 copyright holder to the Batman comic books, Plaintiff
3 has the exclusive right to prepare derivative works.
4 17 U.S.C. § 103(a) ("The subject matter of a copyright
5 . . . includes compilations and derivative works. . .
6 ."). "[T]he protection of derivative rights extends
7 beyond mere protection against unauthorized copying to
8 include the right to 'make other versions of, perform,
9 or exhibit the work.'" Lone Ranger Television v.
10 Program Radio Corp., 740 F.2d 718, 722 (9th Cir.
11 1984) (quoting Russell v. Price, 612 F.2d 1123, 1128
12 n.16 (9th Cir. 1979)). The owner of the underlying
13 work has standing to assert copyright infringement of
14 the derivative work, even when the defendant copies
15 only from the derivative work. 1-3 Nimmer on Copyright
16 § 3.05.

17 "[A] work will be considered a derivative work only
18 if it would be considered an infringing work if the
19 material which it has derived from a prior work had
20 been taken without the consent of a copyright
21 proprietor of such prior work." Litchfield v.
22 Spielberg, 736 F.2d 1352, 1357 (9th Cir. 1984).

23 The Defendant's replica Batmobile vehicles are
24 derivative works of the original Batmobile vehicles.
25 Here, the copyright registration for the 1989 film
26 explicitly states that it is the derivative work of the
27 Batman comic book series and the Batman television
28 series. Joint Stipulation, Ex. 3. The Batmobile

1 vehicle in the 1989 film is derivative of the Batmobile
2 character that appeared in the comic book series, even
3 though the exact design of the 1989 Batmobile is not
4 identical to the original Batmobile vehicles. The 1989
5 Batmobile is merely an adaptation or a recasting of the
6 original Batmobile vehicles. Defendant's copying of
7 the 1989 Batmobile vehicle thus copies from both the
8 derivative 1989 *Batman* film and the Batmobile from the
9 original comic books.

10 The 1966 television series, which copies many
11 elements from the original comic books series including
12 Batman, Robin, and the Batmobile, is a derivative work
13 of the Batman comic book series. The agreement between
14 Plaintiff and ABC requires that ABC give credit to
15 Plaintiff as the originator of the ideas and
16 expressions in the TV show. Joint Stipulation, Ex. 13.
17 As with the 1989 film, the Batmobile in the 1966
18 television show incorporates elements from the
19 Batmobiles in the comic book series and is merely an
20 adaptation of Batmobile character that appeared in the
21 comic books. Defendant's copying of the 1966 Batmobile
22 vehicle copies from both the derivative *Batman*
23 television show and the Batmobile from the original
24 comic books.

25 Accordingly, Plaintiff has standing to assert
26 copyright infringement.

27
28 ///

1 **3. The Batmobile Is Entitled To Copyright**
2 **Protection as a Character**

3 Defendant's Opposition focuses on denying that the
4 Batmobile is entitled to any copyright protection. For
5 the reasons discussed below, the Court finds that the
6 Batmobile is entitled to copyright protection as a
7 character.

8 "Whether a particular work is subject to copyright
9 protection is a mixed question of fact and law"

10 Societe Civile Succession v. Renoir, 549 F.3d 1182,
11 1185 (9th Cir. 2008) (quoting Cavalier v. Random House,
12 Inc., 297 F.3d 815, 822 (9th Cir. 2002)). The owner of
13 a copyright in various works embodying a character can
14 acquire copyright protection for the character itself.
15 See, e.g., Warner Bros. Inc. v. Am. Broad. Co. Inc.,
16 720 F.2d 231, 235 (2d Cir. 1983) ("Plaintiffs own the
17 copyrights in various works embodying the character
18 Superman and have thereby acquired copyright protection
19 for the character itself.") (citation omitted); New
20 Line Cinema Corp. v. Bertlesman Music Group, Inc., 693
21 F.Supp. 1517, 1521 n. 5 (S.D.N.Y. 1988) ("Because New
22 Line has valid copyrights in the Nightmare series, it
23 is clear that it has acquired copyright protection as
24 well for the character of Freddy.") (citing Warner
25 Bros., 720 F.2d at 235).

26 The Ninth Circuit has explained that "copyright
27 protection may be afforded to characters visually
28 depicted in a television series or in a movie." Olson

1 v. Nat'l Broad. Co., 855 F.2d 1446, 1452 (9th Cir.
2 1988) (internal citations omitted). However, it is
3 unclear what legal standard courts should apply in
4 determining whether visually depicted characters are
5 subject to copyright protection. See
6 Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., Inc.,
7 900 F. Supp. 1287, 1295 (C.D. Cal. 1995); Anderson v.
8 Stallone, No. 87-0592 WDKGx, 1989 WL 206431, at *6
9 (C.D. Cal. 1989).

10 The first case to suggest a test for whether or not
11 characters can be copyrighted, Warner Bros. Pictures,
12 Inc. v. Columbia Broadcasting System, Inc., 216 F.2d
13 945 (9th Cir. 1954), stated that literary characters
14 are entitled to copyright protection if the character
15 constitutes "the story being told"; however, if the
16 character is "only the chessman in the game of telling
17 the story" he is not entitled to copyright protection.
18 Id.

19 Subsequent cases appeared to cast doubt on this
20 test. In particular, in Walt Disney Productions. v.
21 Air Pirates, 581 F.2d 751, 755 (9th Cir. 1978), which
22 involved a claim for copyright infringement of Walt
23 Disney's cartoon characters based on the defendant's
24 copying of the characters from Disney's comic books,
25 the Court stated that "while many literary characters
26 may embody little more than an unprotected idea, a
27 comic book character, which has physical as well as
28 conceptual qualities, is more likely to contain some

1 unique elements of expression." Id. (internal
2 citations omitted). The court ultimately concluded
3 that "[b]ecause comic book characters . . . are
4 distinguishable from literary characters, the Warner
5 Brothers language does not preclude protection of
6 Disney's characters." Id.

7 The next Ninth Circuit case to address the issue,
8 Rice v. Fox Broadcasting Co., 330 F.3d 1170 (9th Cir.
9 2003), articulated another standard known as the
10 character delineation test. The Ninth Circuit
11 explained that "characters that are 'especially
12 distinctive' **or** 'the story being told' receive
13 protection apart from the copyrighted work." Rice v.
14 Fox Broad. Co., 330 F.3d 1170, 1175 (9th Cir. 2003)
15 (citing Olson, 855 F.2d at 1452; Metro-Goldwyn-Mayer,
16 Inc., 900 F. Supp. at 1295-96)) (emphasis added). As to
17 the "especially distinctive" standard for
18 copyrightability, the court noted that "[c]haracters
19 that have received copyright protection have displayed
20 consistent, widely identifiable traits." Id. (citing
21 Toho Co. v. William Morrow & Co., 33 F. Supp. 2d 1206,
22 1215 (C.D. Cal. 1998) (Godzilla); Metro-Goldwyn-Mayer,
23 Inc., 900 F. Supp. at 1297 (James Bond); Anderson, 1989
24 WL 206431, at *7 (Rocky Balboa)).

25 The character delineation standard was applied in a
26 recent opinion, where the Ninth Circuit stated that
27 cartoon characters have "physical as well as conceptual
28 qualities, [and are] more likely to contain some unique

1 elements of expression.” Halicki, 547 F.3d at 1223
2 (citing Air Pirates, 581 F.2d at 755.) Halicki did not
3 clarify whether the “story being told” or the character
4 delineation test as articulated in Air Pirates and Rice
5 is the applicable test. However, the opinion suggests
6 that a character is subject to copyright protection in
7 the Ninth Circuit if it satisfies either of the two
8 recognized standards.

9 In Halicki, the Ninth Circuit reviewed, but did not
10 resolve, whether or not the character “Eleanor,” a car
11 that appeared as a 1971 Fastback Ford Mustang in the
12 1974 film, *Gone in 60 Seconds*, was entitled to
13 copyright protection. 547 F.3d at 1217-18. In 2000,
14 Walt Disney Productions released a remake of *Gone in 60*
15 *Seconds* that featured the “Eleanor” vehicle, but this
16 time the vehicle was a 1967 Shelby GT-500. Id. The
17 Ninth Circuit in Halicki noted that the “Eleanor
18 character can be seen as more akin to a comic book
19 character than a literary character.” Id. at 1225.
20 Moreover, Eleanor displays “consistent, widely
21 identifiable traits” because in both films, the
22 characters in the movie have difficulty stealing the
23 Eleanor car. Id. at 1225. The Ninth Circuit remanded
24 to the district court to determine whether Eleanor’s
25 physical and conceptual qualities, and unique elements
26 of expression qualify Eleanor for copyright protection.
27 Id. at 1225.

28 Here, the Court finds that there is no genuine

1 issue of material fact as to whether the Batmobile is
2 "sufficiently delineated" to constitute a character
3 entitled to copyright protection. Defendant repeatedly
4 argues that the Batmobile is not a character because it
5 is a car. This argument lacks merit as the central
6 question in Halicki is not whether the "character" is
7 an object, but rather whether the character conveys a
8 set of distinct characteristics.⁴ Plaintiff's briefing
9 on this issue is conclusory and superficial, but it is
10 clear based on the undisputed facts that the Batmobile
11 is a copyrightable character.

12 It is undeniable that the Batmobile is a world-
13 famous conveyance in the Batman franchise, exhibiting a
14 series of readily identifiable and distinguishing
15 traits. The Batmobile is known by one consistent name
16 that identifies it as Batman's personal vehicle. It
17

18
19 ⁴ Defendant's focus on whether the Batmobile is an inanimate
20 object is also misplaced in light of the fact that at least one
21 other court has afforded copyright protection to an inanimate
22 object belonging to a specific movie character. In New Line
23 Cinema Corp. v. Russ Berrie & Co., 161 F.Supp. 2d 293 (S.D.N.Y.
24 2001), the court found that an inanimate object associated with a
25 fictional character was entitled to copyright protection. In New
26 Line Cinema, a toy distributor sold a toy glove that looked like
27 the glove worn by Freddy Krueger of the *Nightmare on Elm Street*
28 motion pictures. New Line Cinema Corp., 161 F. Supp. 2d at 294.
The court held that the glove was entitled to copyright
protection based on New Line's copyright protection in the Freddy
Krueger character because "[c]opyright protection is extended to
the component part of the character which significantly aids in
identifying the character." Id. at 302 (citing New Line Cinema
Corp. v. Easter Unlimited, Inc., 17 U.S.P.Q.2d 1631, 1633
(E.D.N.Y. 1989); Dallas Cowboys Cheerleaders, Inc. v. Pussycat
Cinema, Ltd., 604 F.2d 200, 204 (2d Cir. 1979)).

1 also displays consistent physical traits. The
2 Batmobile, in its various incarnations, is a highly-
3 interactive vehicle, equipped with high-tech gadgets
4 and weaponry used to aid Batman in fighting crime.
5 Even though the Batmobile is not identical in every
6 comic book, film, or television show, it is still
7 widely recognizable because it often contains bat-like
8 motifs, such as a bat-faced grill or bat-shaped
9 tailfins in the rear of the car, and it is almost
10 always jet black. See, e.g., Joint Stipulation, Ex.
11 25, at 500. The 1989 and 1966 Batmobile iterations
12 also display these physical qualities. In fact, the
13 particular design of the Batmobile often reflects the
14 car models of the time - for example, the Batmobile
15 from the comic book *Batman No. 5*, which was released in
16 1941, has the shape of a 1940s Ford automobile, but
17 contains a "bat" hood ornament and tailfins resembling
18 a bat's wings. Regardless of the evolving design of
19 the Batmobile, it retains distinctive characteristics.

20 Other than its physical features, the Batmobile is
21 depicted as being swift, cunning, strong and elusive.
22 For example, in the comic book *Batman #5*, the Batmobile
23 "leaps away and tears up the street like a cyclone."
24 Joint Stip., Ex. 2, at 75. In the same comic book, the
25 Batmobile is analogized to an "impatient steed
26 straining at the reins," shivering "as its super-
27 charged motor throbs with energy . . . and an instant
28 later it tears after the fleeing hoodlums." Id. at 76.

1 The Batmobile participates in various chases and is
2 deployed to combat Batman's enemies. The comic books
3 portray the Batmobile as a superhero. The Batmobile is
4 central to Batman's ability to fight crime and appears
5 as Batman's sidekick, if not an extension of Batman's
6 own persona.

7 This case is analogous to Toho Co., Ltd. v. William
8 Morrow and Co., Inc., 33 F.Supp. 2d 1206, 1215 (C.D.
9 Cal. 1998), which involved the "Godzilla" character, a
10 giant lizard featured in action films. Although
11 Godzilla assumed many shapes and personalities in the
12 various *Godzilla* films, the Court found that "Godzilla
13 has developed a constant set of traits that distinguish
14 him/her/it from other fictional characters," meriting
15 it copyright protection. Id.

16 For the foregoing reasons, the Court finds that the
17 Batmobile is a character entitled to copyright
18 protection.

19 As further discussed below, Defendant does not deny
20 that he has copied the Batmobile vehicles. Defendant's
21 copying of the two-dimensional Batmobile character,
22 which appeared in the 1989 film, the 1966 television
23 series, and the comic books, into three-dimensional
24 forms is copyright infringement. "It is, of course,
25 fundamental that copyright in a work protects against
26 unauthorized copying, not only in the original medium
27 in which the work was produced, but also in any other
28 medium as well." 1-2 Nimmer on Copyright § 2.08

(2008). "[M]aking decisions that enable one to reproduce or transform an already existing work into another medium or dimension - though perhaps quite difficult and intricate decisions - is not enough to constitute the contribution of something 'recognizably his own.'" Entm't Research Grp., Inc. v. Genesis Creative Grp., Inc., 122 F.3d 1211, 1218 (9th Cir. 1997) (citing Nimmer § 2.08); see also Twentieth Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327, 1329 n.4 (9th Cir. 1983) ("Where defendant's work is adapted for us in a medium different than that of plaintiff's, the test for infringement is the same."); Universal Studios, Inc. v. J.A.R. Sales, Inc., 216 U.S.P.Q. 679, 681, 683 (C.D. Cal. 1982) ("Protection extends to expressions of that character [E.T.] not only in motion pictures, but in other media as well, including three-dimensional expressions such as dolls and other forms of sculpture. . . . The defendants' molded plastic doll is substantially similar to the physical expression of the motion picture character 'E.T.' in that the defendants' doll replicates [E.T.'s] oddly-shaped head and facial features, squat torso, long thin arms, and hunched-over posture. . . . The defendant's molded-plastic doll and the motion picture character E.T. also portray the same mood of lovableness."). Therefore, Defendant's manufacturing of an unauthorized three-dimensional copy of a two-dimensional comic book character, the Batmobile, still

1 constitutes copyright infringement.

2 **4. The Batmobile Is A Work of Pictorial, Graphic,**
3 **and Sculptural Art Entitled to Copyright**
4 **Protection**

5 Alternatively, the Court also finds that the
6 Batmobile is a "pictorial, graphic, and sculptural
7 work" entitled to copyright protection under 17 U.S.C.
8 § 102. Section 101 of the Copyright Act provides that
9 Pictorial, graphic, and sculptural works include
10 two-dimensional and three-dimensional works of
11 fine, graphic, and applied art, photographs, prints
12 and art reproductions, maps, globes, charts,
13 diagrams, models, and technical drawings, including
14 architectural plans. Such works shall include
15 works of artistic craftsmanship insofar as their
16 form but not their mechanical or utilitarian
17 aspects are concerned; the design of a useful
18 article, as defined in this section, shall be
19 considered a pictorial, graphic, or sculptural work
20 only if, and only to the extent that, such design
21 incorporates pictorial, graphic, or sculptural
22 features that can be identified separately from,
23 and are capable of existing independently of, the
24 utilitarian aspects of the article.

25 17 U.S.C. § 101.

26 Courts have traditionally accorded copyright
27 protection to pictorial, graphic, and sculptural works
28 incorporated within a useful article, such as a carving

1 on the back of a chair or an engraving in a glass vase.
2 Leicester v. Warner Bros., 232 F.3d 1212, 1219 (9th
3 Cir. 2000) (citing William F. Patry, 1 Copyright Law
4 and Practice 274-76 (1994)). Only works that "can be
5 identified separately from, and are capable of existing
6 independently of, the utilitarian aspects of the
7 [useful] article" qualify for copyright protection.
8 Id. This is what is known as "separability." Id.

9 Courts have recognized two types of separability:
10 physical separability, and conceptual separability.

11 Id. "Physical separability means that a 'pictorial,
12 graphic or sculptural feature incorporated into the
13 design of a useful article . . . can be physically
14 separated from the article without impairing the
15 article's utility and if, once separated, it can stand
16 alone as a work of art traditionally conceived.'" Id.
17 On the other hand, conceptual separability means that a
18 pictorial, graphic or sculptural feature "can stand on
19 its own as a work of art traditionally conceived, and .
20 . . the useful article in which it is embodied would be
21 equally useful without it." Id.

22 With respect to automobiles, the House Report for
23 the Copyright Act suggests that the statute was not
24 meant to protect merely the aesthetically pleasing
25 features of industrial objects:

26 [A]lthough the shape of an industrial product may
27 be aesthetically satisfying and valuable, the
28 Committee's intention is not to offer it copyright

1 protection under the bill. Unless the shape of an
2 automobile, airplane, ladies' dress, food
3 processor, television set, or any other industrial
4 product contains some element that, physically or
5 conceptually, can be identified as separable from
6 the utilitarian aspects of that article, the design
7 would not be copyrighted under the bill. The test
8 of separability and independence from "the
9 utilitarian aspects of the article" does not depend
10 upon the nature of the design - that is, even if
11 the appearance of an article is determined by
12 aesthetic (as opposed to functional)
13 considerations, only elements, if any, which can
14 be identified separately from the useful article as
15 such are copyrightable.

16 H.R. No. 1476, 94th Cong., 2d Sess. 55 (1976).

17 Defendant repeatedly argues that the Batmobile is
18 only a car and that the design of a car is not
19 protectable under copyright law, citing to the House
20 Report. However, as explained above, the Batmobile is
21 a character and exists in both two- and three-
22 dimensional forms. Its existence in three-dimensional
23 form is the consequence of the Batmobile's portrayal in
24 the 1989 live-motion film and 1966 television series.
25 Defendant did not copy the design of a mere car; he
26 copied the Batmobile character. The fact that the
27 unauthorized Batmobile replicas that Defendant
28 manufactured - which are derivative works - may be

1 "useful articles" is irrelevant. A derivative work can
2 still infringe the underlying copyrighted work even if
3 the derivative work is not independently entitled to
4 copyright protection. Lewis v. Gallob Toys, Inc. v.
5 Nintendo of Am., Inc., 964 F.2d 965, 968 (9th Cir.
6 1992) ("A derivative work must be fixed to be protected
7 under the Act, but not to infringe.") (citing 17 U.S.C.
8 § 102)); Lone Ranger Television, Inc., 740 F.2d at 722-
9 23 ("It makes no difference that the derivation may not
10 satisfy certain requirements for statutory copyright
11 registration itself."); Entm't Research Grp., Inc., 122
12 F.3d at 1218 (three-dimensional inflatable costumes
13 based on copyrighted cartoon characters were not
14 copyrightable).

15 Nevertheless, the Batmobile in its three-
16 dimensional form as it appeared in the 1989 and 1966
17 works is still copyrightable under Section 102. The
18 difficulty with this case is in determining whether or
19 not the Batmobile is an "automobile" and thus a "useful
20 article" that is not entitled to copyright protection
21 except for the conceptually separable elements, or
22 something else entirely. In all of the fictional
23 works, the Batmobile is deployed as Batman's mode of
24 transportation. However, the Batmobile is entirely
25 distinguishable from an ordinary automobile. The
26 Batmobile is a fictional character tied to the
27 fictional Batman character. The Batmobile is a crime
28 fighting weapon and used to display the Batman persona.

1 The Batmobile, and the so-called functional elements
2 associated with it, is not a useful object in the real
3 world, and incorporates fantasy elements that do not
4 appear on real-world vehicles. The "functional
5 elements" - e.g., the fictional torpedo launchers, the
6 Bat-scope, and anti-fire systems - are only
7 "functional" to the extent that they helped Batman
8 fight crime in the fictional Batman television series
9 and movies. Thus, the Batmobile's usefulness is a
10 construct. Additionally, Defendant's argument that
11 Batman is merely a car wholly fails to capture the
12 creativity and fantastical elements that stand apart
13 from the fact that the Batmobile also happens to look
14 like a car.

15 Nonetheless, the *design elements* of the two
16 Batmobiles at issue here are conceptually separable
17 from their underlying car. In particular, the 1989
18 Batmobile's entire frame, consisting of the rear
19 exaggerated, sculpted bat-fin and the mandibular front,
20 is an artistic feature that can stand on its own
21 without the underlying vehicle. The underlying vehicle
22 would still be a car without the exaggerated bat
23 features. Further, the Batmobile's wheels each contain
24 a hubcap containing a bat sculpted from metal, which
25 can literally stand on its own without the underlying
26 wheel.

27 Similarly, the 1966 Batmobile contains features
28 that are conceptually separable from the underlying

1 vehicle. For example, the doors have imprinted upon
2 them red bat logos. The car is painted in a distinct
3 black and red color scheme, where the outline of the
4 car is red. See Knitwaves, Inc. v. Lollytogs Ltd., 71
5 F.3d 996, 1002 (2d Cir. 1995) (the color pattern of
6 useful article entitled to copyright protection). The
7 wheels have hubcaps containing a bat sculpted from
8 metal. The rear of the vehicle is scalloped and
9 intended to look like bat wings. These elements are
10 conceptually separable from the car itself. Further,
11 the interior of the Batmobile contains original
12 features such as the "Bat Scope" and the "Bat Ray" that
13 are subject to copyright protection, as are the names
14 for these features. See 17 U.S.C. § 102 (literary
15 elements are protected under copyright). The interior
16 of the car also has bat-shaped phone. In this
17 instance, while the phone itself is a utilitarian
18 feature, the shape of the phone does not itself have a
19 function and merely displays the figure of a bat.

20 As such, all of the features that distinguish the
21 Batmobile from any other car - the fantastical elements
22 that feature bat design, such as the bat tailfin and
23 the various gadgetry that identify the vehicle as the
24 Batmobile - are protectable elements.

25 Defendant's argument that extending copyright
26 protection to the Batmobile will open the door for the
27 copyrighting of other automobiles. However, the
28 Batmobile is *sui generis*. The unique elements that

1 Plaintiff seeks to protect make the Batmobile the
2 famous vehicle that it is. Thus, the Court finds that
3 the Batmobile is subject to copyright protection.

4 **5. Defendant Has Copied the 1989 and 1966**
5 **Batmobiles**

6 Defendant does not deny that he has reproduced and
7 distributed replicas of the 1966 and 1989 Batmobiles.
8 The only argument that he makes is that he does not
9 include some features in his replicas that were in the
10 original Batmobiles. However, when comparing the
11 replica cars with the Batmobile vehicles that appeared
12 in the television film and movie, his 1966 and 1989
13 Batmobile replicas appear substantially the same as the
14 original Batmobiles. In particular, his replicas for
15 the 1989 Batmobile contain the same exaggerated bat
16 fin, mandibular front, and hubcaps containing the bat
17 symbol. Defendant's replicas of the 1966 Batmobile
18 also has the same color scheme, the same bat tail, and
19 the same bat symbol on the doors and wheels. The
20 interior of the 1966 Batmobile contains labels for many
21 of the features that appeared in the original 1966
22 Batmobile, including the Bat-Ray and Bat-Scope.

23 Further, Defendant does not dispute that he had
24 access to the two 1966 and 1989 Batmobiles. Thus,
25 there is no genuine dispute of fact as to whether or
26 not Defendant's activities constitute "copying" under
27 the requirements for copyright infringement.

28 For the foregoing reasons, the Court **GRANTS**

1 Plaintiff's Motion for Partial Summary Judgment as to
2 copyright infringement and **DENIES** Defendant's Motion.

3 **E. Defendant's Laches Defense**

4 Defendant has asserted laches as a defense to
5 Plaintiff's trademark and copyright claims. Laches
6 requires a showing that (1) Plaintiff's delay in filing
7 suit was unreasonable, and (2) Defendant would suffer
8 prejudice caused by the delay if the suit were to
9 continue. Jarrow Formulas, Inc. v. Nutrition Now,
10 Inc., 304 F.3d 829, 838 (9th Cir. 2002). Defendant
11 bears the burden of demonstrating laches. Id. A party
12 asserting laches must show that it suffered prejudice
13 as a result of the plaintiff's unreasonable delay in
14 filing suit. Id. However, the defense of laches is
15 barred where defendants purposefully committed the
16 infringing conduct. Evergreen Safety Council v. RSA
17 Network, Inc., 697 F.3d 1221, 1228 (9th Cir. 2012).
18 This good-faith component of the laches doctrine is
19 part of the fundamental principle that "he who comes
20 into equity must come with clean hands." Danjaq LLC v.
21 Sony Corp., 263 F.3d 942, 956 (9th Cir. 2001) (citing
22 Hermes Int'l v. Lederer de Paris Fifth Ave., Inc., 219
23 F.3d 104, 107 (2d Cir. 2000)).

24 The limitations period for laches starts "from the
25 time the plaintiff knew or should have known about its
26 potential cause of action." Tillamook Cnty. Smoker,
27 Inc. v. Tillamook Cnty. Creamery Assoc., 465 F.3d 1102
28 (9th Cir. 2006). "While laches and the statute of

1 limitations are distinct defenses, a laches
2 determination is made with reference to the limitations
3 period for the analogous action at law. If the
4 plaintiff filed suit within the analogous limitations
5 period, the strong presumption is that laches is
6 inapplicable." Jarrow Formulas, Inc., 304 F.3d at
7 835-36. If suit is filed outside of the analogous
8 limitations period, courts often have presumed that
9 laches is applicable. Id.

10 As to Plaintiff's trademark infringement claim, the
11 Lanham Act contains no explicit statute of limitations.
12 Id. at 836. When a federal statute lacks a specific
13 statute of limitations, courts may borrow the
14 limitations period from the most closely analogous
15 action under state law. Id. As trademark infringement
16 is a "continuing" wrong, the statute of limitations
17 bars only monetary relief for the period outside the
18 statute of limitations. Id. However, Plaintiff is
19 free to pursue monetary and equitable relief for the
20 time within the limitations period. Id. The
21 presumption of laches is triggered if any part of the
22 claimed wrongful conduct occurred beyond the
23 limitations period. Id.

24 The most closely analogous state-law limitations
25 period for Plaintiff's claims under the Lanham Act are
26 the four-year periods for state trademark infringement
27 and unfair competition claims, set forth under Cal.
28 Code Civ. Proc. § 343 and Cal. Bus. & Prof. Code §

1 17208. Internet Specialties W., Inc. v.
2 Milon-DiGiorgio Enters., Inc., 559 F.3d 985, 999 (9th
3 Cir. 2009). The statute of limitations for copyright
4 claims in civil cases is three years. Petrella v.
5 Metro-Goldwyn-Mayer, Inc., 695 F.3d 946, 951 (9th Cir.
6 2012).

7 The Court finds that there is a genuine dispute of
8 fact with respect to when Plaintiff knew or had reason
9 to know about the infringement of their copyrights and
10 trademarks. Defendant presents evidence showing that
11 an attorney from Warner Bros. called him in 2003,
12 during which the attorney revealed that she saw a
13 photograph of his garage over the Internet. The garage
14 contained a number of 1966 Batmobile replicas and a
15 shell for a 1989 Batmobile replica. Although Warner
16 Bros. is not a party in this Action, the Parties stated
17 at the hearing that Warner Bros. is an affiliate of
18 Plaintiff. The Parties also indicated at the hearing
19 that Warner Bros. enforces Plaintiff's intellectual
20 property. A reasonable fact finder could find that
21 this shows that Plaintiff could have become aware of
22 Defendant's activities in 2003. Further, Plaintiff's
23 Vice President and Deputy Counsel for Intellectual
24 Property testified that Plaintiff was aware that
25 Defendant was manufacturing the Batboat sometime before
26 2006. A reasonable fact-finder could conclude that
27 Plaintiff should have been aware of Defendant's
28 infringing activities as early as 2003. This Action

1 was filed in 2011. On summary judgment, the Court
2 construes the evidence in favor of the non-moving
3 party. As the alleged wrongful acts might have
4 occurred outside the three- and four-year statute of
5 limitations period, laches is presumed.

6 Further, assuming there was delay on the part of
7 Plaintiff, it is unclear whether this delay was
8 reasonable. Specifically, the Parties presented
9 conflicting evidence as to whether or not Plaintiff was
10 diligent in enforcing its copyrights and trademarks.
11 Defendant admitted that he received a few take-down
12 notices regarding his postings on eBay, where he
13 offered his replica vehicles. According to Plaintiff,
14 it requested these take-down notices from eBay, but
15 Plaintiff was unclear as to when these takedown notices
16 occurred and how many notices were issued.

17 Nonetheless, the Court finds that Defendant
18 willfully infringed upon Plaintiff's trademarks.
19 Defendant admitted his knowledge of the Batman property
20 and the various Bat emblems and symbols used with them,
21 and does not dispute that he intentionally copied the
22 designs of the 1989 and 1966 Batmobile vehicles, which
23 included Plaintiff's Batman-related trademarks. He
24 also intentionally referred to his replicas as the
25 Batmobile, a word mark that Plaintiff owns. Thus,
26 Defendant intentionally copied Plaintiff's trademarks,
27 including the Batmobile and Batman word mark and
28 symbols, so as to associate his products with the

1 *Batman* films and television show. Defendant's bad
2 faith deprives him from asserting laches as a defense
3 to Plaintiff's trademark claim. See Bd. of Supervisors
4 of LA State Univ. v. Smack Apparel Co., 438 F. Supp. 2d
5 653, 663 (E.D. La. 2006), *aff'd sub nom.*, Bd. of
6 Supervisors for LA State Univ. Agric. & Mech. Coll. v.
7 Smack Apparel Co., 550 F.3d 465 (5th Cir. 2008). For
8 these reasons, the Court **GRANTS** Plaintiff's Motion, and
9 **DENIES** Defendant's Motion as to Defendant's laches
10 defense to Plaintiff's trademark infringement claim.

11 As to Plaintiff's copyright claim, however,
12 Plaintiff has not demonstrated that Defendant's conduct
13 constitutes willful infringement. For the willful
14 infringement exception to apply to Defendant's laches
15 defense, Plaintiff has to demonstrate that Defendant's
16 conduct occurred "with knowledge that [his] conduct
17 constitutes copyright infringement." Danjaq, 263 F.3d
18 at 958. "Generally, a determination as to willfulness
19 requires an assessment of a party's state of mind, a
20 factual issue that is not usually susceptible to
21 summary judgment." Frank Music Corp. v.
22 Metro-Goldwyn-Mayer, Inc., 772 F.2d 505, 515 (9th Cir.
23 1985). Plaintiff has not demonstrated that Defendant
24 was aware that his conduct of copying the Batmobile
25 vehicles constituted copyright infringement. The
26 record suggests that Defendant believed that only a
27 design patent protected the 1989 Batmobile from
28 infringement. Defendant testified that he waited until

1 the design patent expired before selling his replica
2 cars. Defendant also testified that he was never
3 informed that Plaintiff was asserting copyright
4 ownership to the Batmobile vehicles at issue here.
5 Based on these disputes of fact, the Court cannot
6 determine as a matter of law that Defendant's conduct
7 constituted deliberate infringement. Because there is
8 also a genuine dispute as to when Plaintiff knew or
9 should have known about Defendant's infringement, the
10 Court **DENIES** both Plaintiff and Defendant's Motions as
11 to Defendant's laches defense on the copyright claim.

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1 **IV. CONCLUSION**

2 For the foregoing reasons, the Court **GRANTS in Part**
3 **and DENIES in Part** Plaintiff's Motion for Partial
4 Summary Judgment. The Court **DENIES** Defendant's Motion
5 for Partial Summary Judgment.

6
7 **IT IS SO ORDERED.**

8 DATED: February 7, 2013

9
10 RONALD S.W. LEW

11 HONORABLE RONALD S.W. LEW
12 Senior, U.S. District Court Judge